

HEINER MAX ET AL.
USSN 10/021,627
REPLY TO OFFICE ACTION DATED APRIL 19, 2005
AMENDMENT OF OCTOBER 19, 2005

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why the amendments above are necessary and were not presented earlier. The amendment above to claim 26 is responsive to the objection to claim 27, which was made for the first time in the final rejection. The other amendments are purely editorial in nature and require only a cursory review by the Examiner. Since this is the first substantive response to the final rejection, obviously these amendments could not have been presented earlier. In view of the foregoing, Applicants submit that a proper showing has been made, and, therefore, that the Examiner should enter and consider these amendments. An early notice that these amendments have been entered and considered is earnestly solicited.

Claim 27 was objected to under 37 CFR § 1.75(c) as being improperly dependent upon claim 26. In response, Applicants have amended claim 26 to provide antecedent basis for claim 27.

For the record, Applicants emphasize that although the claims were amended to

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overcome this objection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

Claims 19-25 and 27-32 were rejected under 35 USC § 102(e) as being anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Kung et al. ("Kung"), US 2002/0123460 A1. In response, Applicants point out that the Examiner concedes that Kung does not provide an example having both folic acid and chelator (e.g., EDTA). Indeed, there does not appear to be any specific disclosure in Kung of a combination of folic acid and any chelator, including EDTA. Applicants submit that this failure is sufficient to negate anticipation. As pointed out in *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (BPAI 2003):

"It is well settled, however, that anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose and combine various portions of the disclosure not directly cited to each other by the teachings of the reference."

Although *Beuther* is unpublished, it cites the well-known case of *In re Arkley*, 172 USPQ 524,

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526 (CCPA 1972), which is to the same effect. The Examiner engages in exactly this impermissible picking and choosing to find anticipation here. Kung does not contain a specific disclosure of a combination of folic acid and a chelator. The Examiner finds anticipation by picking and choosing folic acid from Kung's claim 5, then picking and choosing EDTA from examples that show disodium EDTA in combination with ascorbic acid, and, finally, combining these two teachings. Applicants respectfully submit that this negates anticipation, and request that the Examiner reconsider and withdraw at least the anticipation aspect of this rejection.

On the issue of obviousness, Applicants submit that the mere fact that Kung mentions both folic acid and disodium EDTA does not establish a *prima facie* case of obviousness, even if folic acid is disclosed to be a functional equivalent of ascorbic acid. In paragraph 0015, Kung mentions both folic acid and ascorbic acid in a list that comprises literally hundreds of water-soluble oxygen-labile species. Although the claimed invention may be within the generic teachings of the prior art, and could have been achieved with the proper selections, a *prima facie* case of obviousness is not made out unless the prior art highlighted these selections in some manner, and, therefore, led persons skilled in the art towards them. *See, In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.") There is nothing in Kung that highlights folic acid, as opposed to any other of the hundreds of water-soluble oxygen-labile species. Consequently, other than the instant disclosure, there is no motivation for a

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person skilled in the art to pick folic acid out of the list and then replace the ascorbic acid in Kung's examples containing disodium EDTA with folic acid.

In view of the foregoing, Applicants respectfully submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claim 26 was rejected under 35 USC § 103(a) as being obvious over Kung in view of Deckner et al. ("Deckner"), US 4,847,267. In response, Applicants point out that this rejection is premised on Kung anticipating/rendering obvious the elements of Applicants' main claims, which Applicants have shown above is not, in fact, the case. Consequently, the combination of Kung and Deckner still fails to make out a prima facie case of obviousness, as there still is no reason apparent in the combination why a person having ordinary skill in the art should combine folic acid with a chelator, for example, EDTA.

In view of the foregoing, Applicants respectfully submit that the Examiner would be fully justified to reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding

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objections and rejections.

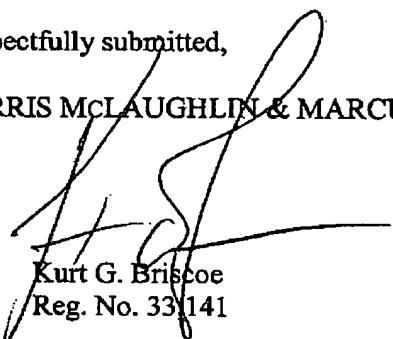
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


Kurt G. Briscoe
Reg. No. 33141

875 Third Avenue
18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Petition for Extension of Time and Notice of Appeal (17 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: October 19, 2005

By:


Kurt G. Briscoe